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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,497	07/05/2001	Hirohisa A. Tanaka	05274.00016	8442

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13
EXAMINER

MCCLELLAN, JAMES S

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 05/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/898,497

Applicant(s)

TANAKA ET AL.

Examiner

James S McClellan

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Amendment

1. Applicant's submittal of an amendment was entered on May 13, 2003, wherein:

claims 1-33 are pending and

claims 1, 2, 7-9, 11-13, 18-20, and 22-33 have been amended.

Applicant's submittal of a drawing change was approved for entry.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 12-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 12 and 23 are hybrid claims. Claims 12 and 23 recite limitations towards a product and a process. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. § 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter, 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. § 112, second paragraph (see M.P.E.P. 2173.05 (p) II.). For example, claim 12 is directed to a "system" (product) that includes a processor and memory and also includes process steps (a) and (b) related to the product.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 12-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 12-33 are rejected under 35 U.S.C. § 101 based on the theory that the claims are directed to neither a “process” or a “machine,” but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. § 101 which is drafted so as to set forth the statutory classes of invention in the alternative only (see M.P.E.P. 2173.05 (p) II.).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 2, 4, 6-13, 15, 17-24, 26, 28-33 rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application No. US 2002/0077130 A1 (Owensby).

Art Unit: 3627

In regards to independent **claim 1**, Owensby discloses a method for determining a billing rate of a mobile telecommunications connection associated with a mobile telecommunications unit (MU) comprising the steps of:

determining whether a location of the MU is inside or outside a predetermined subsidized zone (see paragraph 60);

responsive to a determination that the location of the MU is inside the subsidized zone, adjusting the billing rate for the telecommunications connection to a first predetermined billing rate (see page 11, paragraph 72); and

responsive to a determination that the MU is outside the predetermined subsidized zone, adjusting the billing rate for the telecommunications connection to a second predetermined billing rate (it is inherent that a non-subsidized rate will apply when the user is not in a subsidized zone, see page 12, paragraph 79);

[claim 2] the first predetermined billing rate is less than the second predetermined billing rate (it is inherent that the subsidized rate will be less than the non-subsidized rate);

[claim 4] the location is determined by a Global Positioning System (GPS) (see page 7, paragraph 45);

[claim 6] information corresponding to the predetermined subsidized zone is stored in a database (see page 8, paragraph 52);

[claim 7] the predetermined subsidized zone information comprises a time period (see page 10, paragraph 64; wherein the Ad Selection is determined by among other things, “date and time”), and wherein the billing rate is reduced when the telecommunications connection occurred at least in part during the time period;

Art Unit: 3627

[claim 8] the predetermined subsidized zone is defined by a geographical point and a radius (it is inherent that cellular phone systems include zones that are defined by a radius, see page 7, paragraph 45) ;

[claim 9] the predetermined subsidized zone is associated with a proximity to a commercial establishment (see for example, page 3, paragraph 15, “restaurant in the area”) and the commercial establishment pays the first predetermined billing rate (it is inherent that the commercial establishment pays the subsidy);

[claim 10] the predetermined subsidized zone is one of a plurality of predetermined subsidized zones, each associated with a proximity to a different commercial establishment (it is inherent that the system is used over in a plurality of locations with a plurality of commercial establishments, see page 10, paragraph 60); and

[claim 11] the billing rate is reduced by a first amount when the location of the MU is within a first predetermined subsidized zone, and the billing rate is reduced by a second amount when the location of the MU is within a second predetermined subsidized zone (see page 11, paragraph 72, wherein it is noted that the subsidy is flexible and changes dependent on numerous factors).

In regards to independent **claim 12**, Owensby discloses a system for determining a billing rate of a mobile telecommunications connection associated with a mobile telecommunications unit (MU) comprising: a processor (operator billing system 32, see page 10, paragraph 60); memory for storing computer readable instructions that, when executed by the process, cause the system to perform billing operations. In regards to independent **claim 23**, Owensby discloses a computer program product for determining a billing rate of a mobile telecommunications

Art Unit: 3627

connection associated with a mobile telecommunications unit (MU) comprising a computer-readable medium containing computer program code for performing billing operations. In order to omit redundant explanations of claimed limitations, it is noted that Owensby discloses all the elements cited in claims 12-33 as outlined in detail for similar claims 1-11.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3, 5, 14, 16, 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owensby in view of U.S. Patent No. 6,411,891 (Jones).

Owensby discloses all of the limitations as set forth above but fails to explicitly state alternative methods of determining the geographic location of the mobile unit.

Jones specifically teaches the use of detecting the geographic location of a mobile telecommunications unit by **[claim 3]** longitude and latitude (see column 17, lines 8-10) and **[claim 5]** Universal Transverse Mercator (UTM) numbers (see column 17, lines 8-10).

Since **claims 14 & 16 and 25 & 27** are identical to claims 3 & 5, a detailed description of each limitation will not be repeated.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Owensby with the location detection mechanism of longitude/latitude or UTM as taught by Jones, because the use of an accurate geographic location mechanism as

Art Unit: 3627

taught will improve the efficiency and the successfulness of the advertisements, wherein the system will be able to better pinpoint the proximity of the mobile unit to a commercial establishment.

Response to Arguments

10. Applicant's arguments filed May 13, 2003 have been fully considered but they are not persuasive.

On page 8, second paragraph, Applicant notes that proposed drawing correction of Figure 3 were submitted to overcome objections to the drawings. The proposed drawing change is approved for entry and the objection is withdrawn.

On page 8, third paragraph, Applicant notes that changes were made to claim 1, 12, and 23 to include proper antecedent basis and to better define the claimed invention. The 35 U.S.C. § 112, second paragraph rejection of claims 1, 12, and 23 for lack of antecedent basis is withdrawn.

On page 8, fourth and fifth paragraphs, Applicant traverses the rejection of claims 12-33 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Applicant states that claims 12-33 are directed to program product claims, which are articles of manufacture. Additionally, Applicant notes that the claims have been amended to better define the claimed invention. As set forth above, it appears that claims 12-33 constitute a hybrid claim that overlap a system and process (claim 12) and a computer program product and process (claim 23). As set forth in M.P.E.P. 2173.05 (p) II., a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. § 112, second paragraph

Art Unit: 3627

and should also be rejected as non-statutory under 35 U.S.C. § 101. It is noted that Applicant amended the claims to replace the language "following steps" with "--operations of--". Applicant's amendment does not better define the invention as a single statutory class of invention.

The remaining arguments on pages 8-10 have been fully considered by the Examiner but are rendered moot based on the new grounds of rejections that were necessitated by Applicant's amendment to the claimed invention.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

Art Unit: 3627

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

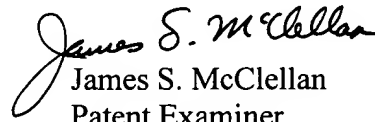
Any response to this action should be mailed to:

Commissioner of Patent and Trademarks
Washington D.C. 20231

or faxed to:

(703) 305-7687 (Official communications) or
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.


James S. McClellan
Patent Examiner
A.U. 3627

jsm
May 27, 2003